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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,205	12/21/2000	Benoit Pol Menez	PU000178	8043

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EXAMINER

ABDI, KAMBIZ

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 12/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,205

Applicant(s)

MENEZ ET AL.

Examiner

Kambiz Abdi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8,11 and 12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this section can be found in the prior office action.

2. The prior office action is incorporated herein by reference. In particular, the observations with respect to claim language. Claim objection of previous office action is withdrawn in view of the amendments to claim 1.

- Claim 12 has been amended.
- Claims 11-12 have been added previously.
- Claims 1-6, 8, and 11-12 are pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5 September 2003 has been entered.

Response to Amendment

4. Applicant's arguments with respect to claim 1 and consequently of claims 5, 11, and 12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC §101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

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6. Claims 1-6, and 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. See analysis language below:

7. The claims are directed to a process that does nothing more than manipulate an abstract idea. There is no practical application in the technological arts. As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

8. Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

9. This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not

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render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

10. In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

11. The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological

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arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

12. The claims, as presently claimed and best understood were considered in light of the new "Examination Guidelines for Computer-Related Inventions" as been mentioned above and were found to be non-statutory. Discussion of the analysis of the claims under the guidelines follows.

13. The specification has been reviewed to see if the disclosed invention is in the technological art and that it has a practical use in the art. The review shows that the system uses a computerized method or system to achieve the setting up of sub-accounts that are controlled by the limitations that have been created by the some one other than the user of the credit card.

14. It is noted that method claims 1 and 5 fail to recite/define a computer, machine or device that would render the claims in the technological arts and in statutory status.

15. Furthermore, it is also noted that there is no interrelationship between the independent claim preambles and bodies of the claims. Therefore claims 1 and 5 have been rejected. Furthermore, claims 2-4, 6, and 8 being dependent on rejected independent claims 1 and 5 are rejected as well.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1-6, 8, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,559,871 to David B. Smith

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17. As per claim 1 and 11, Fleming clearly discloses a method and a system for processing user programming request, comprising the steps of:

Detecting a user request; Providing a plurality of selectively actuatable entries for single-user spending limits each spending limit being associated with a different-length time period, in response to the user request; Receiving selection of at least one of the plurality of selectively actuatable entries and a spending limit for the selected at least one of the plurality of selectively actuatable entries; and Tracking user spending during the time period associated with each selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

18. As per claim 2, The method of claim 1 further comprising

the step of providing a selection for a rolling time period (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

19. As per claim 3, The method of claim 1 further comprising

the step of generating a user warning when the user spending exceeds the spending limit during the time period for any selected entry (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

20. As per claim 4, The method of claim 3 further comprising

the step of allowing the user to override the user spending limit (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

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21. As per claim 5 and 12, a method for processing user programming request, comprising the steps of:

detecting a user request; providing a plurality of spending limit entries for a single user each entry corresponding to a different time period, in response to the user request; receiving selection of a spending limit for at least one of the spending limit entries; and tracking user spending during each different time period for which a spending limit was received (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

22. As per claim 6, The method of claim 5 further comprising

performing a check to see if a spending limit for a shorter time period is greater than a spending limit entry for a longer time period; and providing a user warning if the spending limit for the shorter time period is greater (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

23. As per claim 8, The method of claim 5 further comprising

the step of providing a selection for tracking each different selected time period on a rolling basis (See Smith abstract, figures 2-10 and associated text, column 1, lines 43-68, column 2, lines 1-35, column 3, lines 52-68, column 4, lines 30-47, and column 5, lines 46-62).

24. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response,

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to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be reached on 9:30 AM to 5:00 PM.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks
Washington, D.C. 20231**

or faxed to:

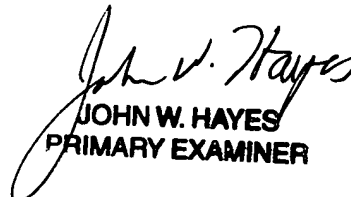
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K
December 1, 2003**


**JOHN W. HAYES
PRIMARY EXAMINER**